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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 9
EJS

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Consumer Insurance Group, Inc.

Serial No. 75/772,303

Thomas S. Birney of Dorr, Carson, Sloan & Birney, P.C. for
Consumer Insurance Group, Inc.

Doritt Carroll, Trademark Examining Attorney, Law Office
115 (Tomas Vlcek, Managing Attorney)

Before Simms, Seeherman and Wendel, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Consumer Insurance Group, Inc. has appealed from the
final refusal of the Trademark Examining Attorney to
register ETERM as a service mark for "insurance brokerage."¹
Registration has been refused by the Trademark Examining
Attorney pursuant to Section 2(e)(1) of the Trademark Act,

¹ Application Serial No. 75/772,303, filed August 10, 1999, and
asserting first use and first use in interstate commerce on
May 8, 1998.

15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of applicant's services.

Applicant and the Examining Attorney have filed appeal briefs.² An oral hearing was not requested.

It is the Examining Attorney's position that ETERM is merely descriptive because it immediately conveys to consumers that applicant provides term insurance electronically via a global computer network. In support of this position, the Examining Attorney has made of record dictionary definitions of **term insurance** -- "insurance providing coverage for losses to the insured during a stated period but becoming void upon its expiration"³ and **e-** -- "an abbreviation of "electronic" that generally indicate [sic] information or functions involving the Internet";⁴ excerpts taken from various websites showing use of the "e-" prefix for Internet-related goods and services, including

² In its brief applicant listed certain "E" marks. The Examining Attorney has objected to our consideration of this "evidence." The objection is well taken. Trademark Rule 2.142(d) provides that the record in an application should be complete prior to the filing of an appeal. Evidence cannot be made of record with the appeal brief. Apart from the untimeliness, the submission of a list of registrations is insufficient to make them of record. **In re Duofold Inc.**, 184 USPQ 638 (TTAB 1974). In any event, even if the registrations had been properly made of record, they would not cause us to reach a different result in this case. See **In re Styleclick.com, Inc.**, 57 USPQ2d 1445 (TTAB 2000).

³ The American Heritage Dictionary of the English Language, 3d ed. © 1992, electronic version.

⁴ Official Internet Dictionary, © 1998.

"e-business", "e-conferences" and "e-commerce"; and excerpts from the LEXIS-NEXIS data base showing use of "e-insurance," including the following:

First Union Corp. has purchased Professional Direct Agency, an online insurance agency, for \$4.35 million in case in order to move into e-insurance. "The American Banker," July 26, 2000

The field of "e-insurance" alone, dedicated to streamlining all aspects of the insurance business, has produced nothing short of an explosion of new companies...
"The Washington Post," July 16, 2000

...Internet to streamline and automate the insurance distribution process to facilitate end-to-end transaction processing. Carriers and distributors can significantly decrease costs, increase revenue and improve service levels by using ChannelPoint's applications and Exchange Platform technology to conduct e-insurance transactions.
"National Underwriter," May 22, 2000

Moreover, the Examining Attorney has pointed to applicant's own materials to demonstrate that applicant's insurance brokerage services include term insurance, and that applicant provides its insurance brokerage services via the Internet. Its website states that "**eterm** is committed to making it as easy and convenient as possible for you to purchase the quality, low-cost term life insurance that you need." Further, its very specimens are

excerpts from its website, and advertise the ETERM services as "Web's Fastest Life Insurance Quote."

A mark is merely descriptive, and therefore prohibited from registration by Section 2(e)(1) of the Act, if it immediately conveys knowledge of the ingredients, qualities or characteristics of the goods (or services). **In re Gyulay**, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); **In re Venture Lending Associates**, 226 USPQ 285 (TTAB 1985). In this case, based on the evidence of record, we find that ETERM immediately conveys to purchasers of applicant's insurance brokerage services that applicant offers term insurance electronically, through the Internet/global network.

The evidence demonstrates that the prefix E- is used to show that products and services are offered through or utilize the Internet. The evidence also shows that TERM is a descriptive term which identifies a type of insurance, and that such insurance is offered through the Internet. When these elements are combined as ETERM, and used for insurance brokerage services, the mark immediately conveys to consumers that term insurance is being offered electronically through the Internet. See **In re Styleclick.com Inc.**, 57 USPQ2d 1445, 1448 (TTAB 2000) ("in sum, 'e-,' when used as a prefix in the manner of

applicant's mark, has the generally recognized meaning of 'electronic' in terms of computers and the Internet. When this non-source-identifying prefix is coupled with the descriptive word 'fashion,' the mark E FASHION, as a whole, is merely descriptive for applicant's goods and/or services.")

Applicant argues that ETERM is a coined term and not a word in the English language. However, as stated above, the use of the "E-" prefix is generally used to indicate information or functions involving the Internet, such that when E is combined with TERM, and the resulting ETERM is used for insurance brokerage services, people will immediately understand the meaning of this term.

Applicant also appears to argue that consumers would not know, from the term ETERM alone, that applicant offers insurance brokerage services, and asserts (without any evidentiary support) that ETERM "is used as an acronym for 'terminal emulation' software at www.eterm.org." Brief, p. 3. Applicant also states that the word "term" by itself has a wide variety of possible meanings unrelated to life insurance.

The fallacy of applicant's position is that the question of registrability is not decided in a vacuum, but in relation to the goods on which, or the services in

connection with which, it is used. Applicant's approach—whether the word conveys the characteristics, qualities, etc. of a product or service to one who does not know what the product or service is, was rejected by our primary reviewing Court in **In re Abcor Development Corporation**, 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

Applicant has also pointed out that the Patent and Trademark Office previously published, in 1998, an application for ETERM for insurance services, thereby indicating that the Office has taken a position that the mark is inherently distinctive. As the Board recognized in **In re Styleclick.com Inc.**, supra, there has been inconsistent treatment by the Office with respect to "e-" prefix marks. The Board suggested the inconsistencies may have been due to the fact that previously the meaning of the "e-" prefix may have been known only by those few who were then accessing the Internet. At this point in time, we have no doubt that the meaning of the "e-" prefix is commonly recognized and understood by virtually everyone as a designation for the Internet. Id. Accordingly, the fact that a previous application for ETERM for insurance services was approved for publication by an Examining Attorney does not persuade us that the same result should occur in this case. As has been frequently stated, each

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case must be decided on its own merits. In view of the record herein, we have no doubt that ETERM is merely descriptive for insurance brokerage services.

Decision: The refusal of registration is affirmed.